

REMARKS

**1. Claim Rejections -- 35 U.S.C. § 103**

Claims 1-3, 5, 7-18, and 21-24 stand rejected under 35 U.S.C. § 103(a) ("Section 103") as being unpatentable over U.S. Pat. No. 6,317,718 to Fano ("Fano") in view of U.S. Pat. No. 6,269,348 to Pare Jr. ("Pare") and U.S. Pat. No. 6,199,753 to Tracy ("Tracy"). Further, claims 1-3, 5, 7-18 and 21-24 stand rejected under Section 103 as obvious in view of U.S. Pat. No. 6,587,835 to Treyz ("Treyz") and further in view of Pare.

An invention is unpatentable under Section 103 "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

To establish a *prima facie* case of obviousness, three criteria must be met. "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2142.

A "clear and particular" showing of the suggestion to combine or modify is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant's claims are not obvious in view of the prior art references.

In rejecting Applicant's claims, Examiner has disregarded significant claim limitations of the present application, as amended. Specifically, Applicant's independent claim 1, as amended, recites an apparatus for use by a purchaser that comprises a "short range communications device for wirelessly transceiving point-of-sale purchase information between said short range communications device and a vendor device located at a point-of-sale and selectively wirelessly forwarding authorization information received from an authorization provider to said point-of-sale vendor device." Such limitations are also present in Applicant's independent claims 5, 9 and 13. Such limitations add no new subject matter as each finds support in the specification originally filed.

Fano, on the other hand, teaches an agent based system that utilizes a Personal Digital Assistant (PDA)-based, Global Positioning System (GPS)-enabled information gathering agent to create a customized offer information summary based on the location of a user and one or more items of interest. Indeed, Fano is directed primarily to facilitating and enhancing the process of shopping, specifically with respect to comparison shopping. Although Fano briefly mentions that the invention "facilitates the transaction itself and can be used as a channel through which product service can be delivered," (col. 52, ln. 6-8), Fano fails to disclose any specifics as to the manner in which such a purchase transaction may be completed. Thus, Fano fails to disclose or suggest a purchaser device capable of selectively wirelessly communicating purchase information and authorization information to a vendor device at a point of sale as claimed by the present application. Moreover, as the Examiner notes, Fano neither discloses nor

suggests a purchaser device capable of communicating with an authorization provider to receive authorization information.

Pare also fails to disclose or suggest a purchaser device capable of communicating with an authorization provider to receive authorization information that may be selectively wirelessly transmitted to a vendor device in accordance with the present invention. Indeed, the Examiner's suggestion that Pare may be combined with Fano to render obvious the present invention constitutes an improper rejection based on hindsight.

Indeed, Pare neither discloses nor suggests selectively wirelessly transmitting authorization information from a purchaser device to a vendor device as claimed in the present application. Although Pare discloses a method for authenticating and receiving authorization information, Pare fails to mention any application for transmitting such information between more than one device at a point of sale. Indeed, in the section entitled "Retail Point of Sale Transactions," Pare emphasizes that a payor may initiate a purchase by providing purchase information and identification information on "a PLA (Party Identification Apparatus) controlled by payee." (Col. 15, ln. 20-23). In this manner, Pare teaches away from any communication between a purchaser device and a vendor device as taught by the present application as the purchase information and authorization information in Pare is isolated on a single device controlled by payee.

As neither Fano nor Pare suggest the combination asserted by the Examiner and since, even if combined as the Examiner suggests, the references will not produce Applicant's invention, claims 1, 5, 9 and 13 are not rendered obvious under Section 103 in view of such references.

Similarly, Treyz teaches a system in which a handheld computing device may be used to provide a user with shopping assistance services. Although Treyz mentions that a “handheld computing device may transmit financial information to computer to purchase products or services from facility in a wireless purchase transaction,” (col. 65, ln. 54-60), Treyz neither discloses nor suggests a system in which authorization information may be obtained by the handheld purchaser device from an authorization provider and selectively wirelessly transmitted to a vendor device, as claimed by the present application. Indeed, Treyz fails to disclose or suggest authorizing a purchase at all.

Also, as discussed above, even where Pare is considered in connection with Treyz, the present invention is not rendered obvious. As Pare neither discloses nor suggests transmitting authorization information between more than one device, one skilled in the art would not be motivated by Pare to modify Treyz to include the Pare authorization information system, especially where Treyz is directed primarily to a purchaser device and Pare emphasizes that the device claimed therein is “controlled by payee” in a point of sale transaction (col. 15, ln. 23-24).

Thus, independent claims 1, 5, 9 and 13 are not rendered obvious in light of the cited art as no reference, nor combination thereof, teaches nor suggests the present invention as claimed.

Remaining claims 2-3, 7-8, 10-12, 14-18 and 21-24 place further limitations on otherwise allowable subject matter and should not therefore be considered obvious under Section 103.

Based on the foregoing, Applicant submits that the prior art does not render claims 1-3, 5, 7-18, and 21-24 of the present invention obvious. As such, Applicant

respectfully requests that the claims of the application be reconsidered and that the claim rejections under Section 103 be withdrawn.

CONCLUSION


Based on the foregoing, Applicant respectfully submits that the deficiencies in the application have been corrected and that the proposed claims, as amended, are neither anticipated nor rendered obvious by the prior art references cited by the Examiner. As such, Applicant believes that the claims are now in a condition for allowance, and action to that end is respectfully requested.

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

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Respectfully submitted,

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